

REMARKS

By this Amendment, the title of the invention and claims 1 and 4-6 have been amended, claims 2, 3 and 9 have been canceled, and new claims 15-22 have been added to the application. Accordingly, claims 1, 4-6, 10 and 15-22 are pending in the application. No new matter has been added.

In the prior Office Action, the Examiner acknowledged applicant's prior election, without traverse, to prosecute the invention of Group I, claims 1-6, 9 and 10. The Examiner then noted, incorrectly, that applicant elected to withdraw the invention of Group II, claims 12-21. In point of fact, prior to the instant Amendment, there were only 14 claims in the application. The invention of Group II encompassed claims 7 and 8, which claims were canceled; and not withdrawn. Applicant also canceled claims 11-14, which were drawn to non-elected invention Groups III and IV.

Next, the Examiner correctly noted that the present application claims priority to PCT/EP03/10853, filed September 30, 2003, DE 102 48 314.0, filed October 16, 2002 and DE 103 17 982.8, filed April 17, 2003. The Examiner then incorrectly stated that applicant is only entitled to priority from PCT/EP03/10853 because such application was purportedly filed more than twelve months after DE 102 48 314.0 and DE 103 17 982.8. Clearly, the Examiner is mistaken. PCT/EP03/10853 was filed on September 30, 2003, within twelve months of both German priority applications (which were filed on October 16, 2002 and April 17, 2003, respectively). Applicant is clearly entitled to claim priority to both German applications under 35 U.S.C. §119(a)-(d). Applicant respectfully requests acknowledgment of the claim of priority to DE 102 48 314.0, filed October 16, 2002 and DE 103 17 982.8, filed April 17, 2003.

In the prior Office Action, the Examiner objected to the title of the invention on grounds that it was not descriptive of the invention. By this amendment, applicant has amended the title of the invention such that it is clearly indicative of the invention to which the claims are directed.

The Examiner also objected to claims 2, 3 and 10 as being of improper dependent form for failing to further limit the subject matter of the claim from which they depend. By this Amendment, claims 2 and 3 have been canceled, thereby rendering

the prior objection thereto moot. In addition, claims 1 and 10 have been amended. Claim 1, as amended, does not require the presence of any active substances and/or auxiliary substances. Claim 10, as amended, specifies that the shaped article is contacted with an aqueous solution comprising one or more active substances and/or auxiliary substances. Thus, claim 10 is now narrower in scope than claim 1. New claim 17 specifies that the shaped article comprises one or more active substances and/or auxiliary substances. Claim 17 is also narrower in scope than claim 1.

Also in the prior Office Action, the Examiner rejected claims 1-6, 9 and 10 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner requested clarification in the preamble to claim 1 whether a method of preparing a composition or a method of using a composition was being claimed. Accordingly, claim 1 has been amended to clarify that the claimed invention is directed to a method of using a shaped article to apply at least one scaffold-forming agent to an external skin and/or hair surface of a human or an animal.

The Examiner also rejected claim 1 under 35 U.S.C. §112, second paragraph, on grounds that use of the term "and/or" made the ultimate composition of the material applied to the external skin and/or hair surface of the human or the animal unclear. By this Amendment, claim 1 has been amended to delete the term "and/or" and also to delete any reference to the optional components. The term "comprising" in claim 1 allows for the presence of optional components, even though such optional components are not expressly recited in claim 1. Dependent claims 15-22 have been added to the application to claim embodiments in which the previously mentioned optional components are present. The foregoing amendments thus clarify the minimum composition of the material applied to the external skin and/or hair surface of the human or the animal.

Also in the prior Office Action, the Examiner rejected claims 1-5, 9 and 10 under 35 U.S.C. §102(b) as being anticipated by an Dogliani (EP 0 888 769). Dogliani discloses thick leaves or sheets, which are applied directly on the skin and then rehydrated with water or an aqueous solution. In one embodiment, the thick leaves or sheet are in the form of a facial mask. After hydration, the thick leaves or sheets turn

into a gel a few centimeters thick, which can be absorbed by the skin in about 10 minutes. In contrast to Dogliani, applicant's method, as claimed, utilizes shaped articles having a small volume and diameter (not thick leaves or masks), which are contacted with water to form a solution or a gel and then applied to the skin or hair in that form.

The Examiner also rejected claims 1-3, 6, 9 and 10 under 35 U.S.C. §102(b) as being anticipated by Wunderlich et al., U.S. Pat. 5,578,307. As noted by the Examiner, Wunderlich et al. discloses shaped articles that comprise skeleton builders. In every case, a protein-based skeleton-builder must be used. See, e.g., col. 3, lines 4-11:

In particular, the present invention provides shaped articles containing a plant extract, which comprise a dispersion of the plant extract in a matrix composed predominantly of a skeleton builder of hydrophilic macromolecules selected from the group consisting of: collagen, gelatin, fractionated gelatin, collagen hydrolysates, gelatin derivatives, elastin hydrolysates, plant proteins, plant protein hydrolysates; and their mixtures.

Wunderlich et al. do teach the use of non-protein based skeleton builders, but only as additives in addition to the protein-based skeleton builders noted above. See, e.g., col. 8, lines 36-46:

Furthermore, it may be advantageous from the technological point of view to add other skeleton-building substances to the formula in addition to the skeleton builder of hydrophilic macromolecules.

Additional skeleton builders which can be employed are: albumins, agar-agar, gum arabic, pectins, tragacanth, xanthan, natural and modified starches, dextrans, dextrans, maltodextrin, chitosan, alginates, cellulose derivatives, sugars, such as, for example, sucrose, glycine, lactose, PVP (polyvinylpyrrolidone), mannitol and combinations of the abovementioned substances, but in particular mannitol.

There are no embodiments or teachings in Wunderlich et al. whereby one of ordinary skill in the art would be motivated to form a shaped article that does not contain any protein-based scaffold-forming agents such as claimed in claim 1 of the present

application. Thus, Wunderlich et al. teaches the use of protein-based agents. Claim 1, as amended, prohibits the presence of protein-based scaffold-forming agents.

Finally, in the prior Office Action the Examiner rejected claims 1-6, 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Dogliani and Wunderlich et al. Applicant respectfully submits that Dogliani and Wunderlich et al. cannot be combined so as to establish a *prima facie* case of obviousness. Wunderlich et al. teaches the use of protein-based scaffold-forming agents, which are expressly excluded from applicant's shaped articles, as claimed. There is no teaching or suggestion in either reference that one should expressly omit protein-based scaffold-forming agents. Furthermore, Dogliani is directed to a mask that is hydrated while situated on the skin, and not to a shaped article that is hydrated to form a gel or lotion that is then applied to the skin.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge the same to Deposit Account No. 18-0160, Order No. GIL-16027.

Respectfully submitted,

RANKIN, HILL & CLARK LLP

By: /Randolph E. Digges, III/
Randolph E. Digges, III
Reg. No. 40590

700 Huntington Building
925 Euclid Avenue
Cleveland, Ohio 44115-1405
TEL: (216) 566-9700
FAX: (216) 566-9711
docketing@rankinhill.com